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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,033	09/28/2001	Joshua R. Smith	103140-0012U1	7207

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EXAMINER

SMITH, TRACI L

ART UNIT PAPER NUMBER

3629

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,033

Applicant(s)

SMITH ET AL.

Examiner

Traci L. Smith

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7, 9-11, 13, 20-26, 28-30 and 32 is/are pending in the application.
- 4a) Of the above claim(s) 3, 7, 9-11, 13, 20 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 2, 4, 21-24 and 28-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to papers files on February 8, 2006.
2. Claims 34-47 have been withdrawn.
3. Claims 2-4,7,9-11,13,20-26,28-30 *and* 32 are pending.
4. Claims 3, 7, 9-11, 13, 20 and 32 have been withdrawn by examiner.
5. Claims 2, 4, 21-24 and 28-30 are rejected.

Election/Restrictions

6. Applicant's election with traverse of Species C tracing package information with regards to the contents of the package in the reply filed on February 8, 2006 is acknowledged. The traversal is on the ground(s) that all claims of the restriction group I are in the same class and would not be an undue search on the examiner. This is not found persuasive because the election of species is not made due to amount of searching required or classification of inventions the election is because the species are considered **distinct** inventions, species can fall into the same class/subclass but still be different from each other.

The requirement is still deemed proper and is therefore made FINAL.

7. Claims 3, 7, 9-11, 13, 20 and 32 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on February 8, 2006.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2, 4, 21-24 and 28-30 recites the limitation "the respective users", "the mail piece sender", "the identified users", "the listing", "the contents", "the delivery status" "the image", "the mail piece sender" in several sections of all the above listed claims. There inconsistent language between pluralities and later single usage i.e., "produce listings" and "the listing" as well as user identifiers are not the same as "the identified users" and "user identifiers are not the same as "the respective users". There is insufficient antecedent basis for this limitation in the claim. Applicant is requested to review claims and correct the above noted insufficiencies to maintain language continuity.

10. Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims list "respective users" then in later steps recite "given users". Examiner is unable to determine if the "users" are the same or if there are two types of users being claimed.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 2, 4, 21-24 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,285,916 Multi-stage Parcel Tracking System; Kadaba et al.; hereinafter referred to as Kadaba.

12. As to claims 2, 4, 21-24 and 28-30 Kadaba teaches

a. Matching user id, tracking numbers, names etc with parcels being shipped and shipping status(C. 7 l. 30-35)

13. Displaying a message to a user indicating the status of the shipped parcel(C. 7 l. 65-67 & C. 8 l. 1-2). The examiner notes that "information relating to contents" is also status information. If there parcel is in transit then the contents of the parcel are therefore in-transit as well. However, as to applicants "information relating to contents" and "image of contents" these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. **The steps would be performed regardless of the information or images presented.** Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see in re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 44(Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ 2d 1031(Fed. Cir. 1994).

b. Allowing the user to view the information over a computer network(C. 8 l. 9-15).

c. Computers for displaying tracking information to the user(C. 9 l. 43-46).

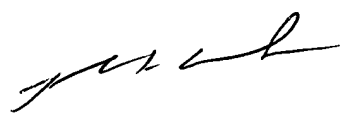
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traci L. Smith whose telephone number is 571-272-6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TLS


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